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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,726	06/18/2001	Rika Iwao	FUJI 124	7959

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EXAMINER

HARRELL, ROBERT B

ART UNIT PAPER NUMBER

2142

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/881,726

Applicant(s)

IWAO, RIKA

Examiner

Robert B. Harrell

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on October 9, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: see attached Office Action.

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1. Claims 1-12 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
3. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, and clarity of meaning in the Specification, Drawings, and specifically claims. Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
4. The following is a quotation of the second paragraph of 35 U.S.C 112:

**The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

5. Claims 1-12 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The scope of meaning of the following claim language is not clear:

a) "the user identifier"--claim 2 (line 14)[note line 4 and 10 "a user identifier")].

6. As to 5 (a) above, this is but an example of numerous cases where clear antecedent bases are lacking and not an exhausting recital. Any other term(s) or phrase(s) over looked by examiner and not listed above which start with either "the" or "said" and do not have a single proper antecedent bases also is indefinite for the reasons outlined in this paragraph. Also, this is but an example where term(s) or phrase(s) are introduced more than once without adequate use of either "the" or "said" for the subsequent use of the term(s) or phrase(s). Moreover, multiple introduction of a term, or changes in tense, results in a lack of clear antecedent bases for term(s) or phrase(s) which relied upon the introduced term. Failure to correct all existing cases where clear antecedent bases are lacking can be viewed as non-responsive.

7. The claims are drafted in "means-plus-function" format. However, associating the claimed elements with the corresponding structure in the specification is near impossible when the specification itself uses such a format (e.g., see page 2 (line 13) as but one example).

8. Claim 1 recites a "first reception means for receiving registration data including a user identifier and user data". However, it cannot be clearly ascertained if the registration data includes both user identifier and user data, together, or if the reception means has two

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inputs, one for the registration data that includes only a user identifier and a second input for the user data.

reception means  $\leftarrow$  registration data:=(user identifier (+) user data)

or

reception means  $\leftarrow$  registration data:=(user identifier)  
 $\leftarrow$  user data

That is to say, is the user data part of the registration data or is the user data input separately from the registration data and not included as part of the registration data. The same holds for claim 2 with respect to "recipient identifier" as it cannot be clearly ascertained if the recipient identifier belongs in the set of the registration data or is entered separately from the registration data.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

10. Claims 1-12 are rejected under 35 U.S.C. 102 (e) as being anticipated by Carey et al. (US 6,714,793 B1).

11. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature as the whole of the reference is cited and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

12. Per claim 1 and claim 2, using claim 2 as a guide since claim 1 is broader in breath and contains those elements of claim 2, and in light of the corresponding structures and/or acts of this application, Carey taught a server apparatus (e.g., see figure 1 (20)) for administering communications of a portable terminal device (e.g., see figure 1 (36) and figure 10), comprising:

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- a) first reception means (e.g., see figure 1 (42)) for receiving registration data including a user identifier, user data, a recipient address and a recipient identifier (e.g., see Abstract and col. 4 (lines 6-63) in that a user uses one's personal computer to "register" the person's user identification (user id), user data (such as messages to be pre-stored), recipient address (buddy's cell phone numbers and the like), and recipient identifier (buddy name));
- b) storage means (e.g., 26 and/or 40) for storing the user data, user identifier, recipient address and recipient identifier received by the first reception means such that they are associated with each other (e.g., see col. 4 (lines 22-33) and col. 5 (line 44) to col. 6 (line 5));
- c) second reception means (e.g., see figure 1 34 and/or 32)) for receiving a user identifier and a recipient identifier from the portable terminal device (e.g., see col. 6 (line 61) to col. 7 (line 18));
- d) retrieval means (e.g., see figure 1 (22)) for retrieving user data and a recipient address associated with the user identifier and recipient identifier received by the second reception means from the storage means (e.g., see col. 6 (line 61) to col. 7 (line 188); and
- e) transmission means (e.g., see figure 1 (34)) for transmitting the retrieved user data based on the retrieved recipient address (note lightning bolt of figure 1 between elements 34 and 36)).

13. Per claims 3, 4 and 12, in the above description, the data registration was conveniently made from the user terminal 42 such as PC, and such way of registration is preferred per col. 4 (lines 6-11) and col. 3 (lines 35-49).

14. Per claim 5, col. 4 (line 27) states that the destination address (recipient address) was "preferably a phone number". "Preferably" suggest other means of identification such as URL since Carey was directed to Web Based system as indicated above and per col. 3 (line 37 "Internet") and col. 4 (line 9 "web site")); specifically since the system was directed to AOL Buddy List (e.g., see figure 10 (228)).

15. Per claim 6, see col. 6 (line 20).

16. Per claim 7, the reference taught "Buddy List" a known term including as user group(s) per col. 4 (line 18).

17. Per claim 8, see figure 1 and 14.

18. Per claim 9, this claim is stated in --"or"-- and figure 14 shows at least a character; thus meeting the --"or"-- condition. It is noted that a character is a subset of the set "image" [e.g., a "smiley face" is provided by visual image → :) ← ]. Furthermore, Carey was aware of "voice" per col. 1 (line 57) in that his system provided a cheaper communication form to compliment, and not total elimination of, voice and thus such col. 1 (line 57) does not teach away from his **disclosed** invention.

19. Per claim 10, see col. 3 (lines 32-34) in that the conventional personal computer could partake in the instant messaging as well as be used for registration within the system.

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20. Per claim 11, fees were covered with respect to col. 1 (line 56 "costly").

21. A shortened statutory period for response to this action is set to expire **3 (three) months** and 0 (zero) days from the date of this letter. Failure to respond within the period for response will cause the application to become **abandoned** (see MPEP 710.02, 710.02(b)).

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (703) 305-9692. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and **on weekends from 6:00 am to 12 noon Eastern Standard Time.**

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey, can be reached on (703) 308-9705. The fax phone number for all papers is (703) 872-9306.

24. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL  
PRIMARY EXAMINER  
GROUP 2142